

REMARKS

Claims 1 and 4-20 are pending in the present application.

The rejection of Claims 1, 2, and 18-20 under 35 U.S.C. §102(a) over Luzzio et al is traversed.

At the outset, Applicants note that Luzzio et al published on December 13, 2001. In contrast, the present application was filed as International Application No. PCT/JP00/04298 (corresponding to WO 01/02359) on June 29, 2000, which is nearly 18 months prior to the publication of Luzzio et al. The present application claims priority under 35 U.S.C. §120 to this International Application No. PCT/JP00/04298.

MPEP §1895 states:

To obtain benefit under 35 U.S.C. 120 of a prior PCT application designating the U.S., the continuing U.S. national application must  
(A) include an appropriate reference to the prior PCT application (either in the application data sheet (37 CFR 1.76) or in the first sentence of the specification),  
(B) be copending with the prior PCT application, and  
(C) have at least one inventor in common with the prior PCT application.

See MPEP § 201.11. A U.S. national application is copending with an international application (PCT) if the prior international application was pending on the filing date of the subsequent U.S. national application. If the prior application is an international application, the examiner must ascertain (B) and (C) above...

Applicants note that the specification was amended on December 31, 2001 to include the appropriate reference to the prior PCT application. In addition, the application data sheet clearly claims the right to priority to the PCT application. As such, they have met their burden. Further, the Examiner has not called into question the right to priority under (B) or (C) above. As such, Applicants submit that they should be entitled to the benefit of priority as set forth above.

The Examiner states that Applicants are not entitled to the filing date of International Application No. PCT/JP00/04298 since an English Translation of this application has not been filed. The Examiner points to MPEP §1895.01; however, Applicants note that this section merely states: “a copy of the international application (and an English translation) *may* be required by the examiner to perfect the claims for benefit under 35 U.S.C. §120” (emphasis added).

Although not explicitly stated by the Examiner, it appears that the Examiner is requiring the submission of an English translation of WO 01/02359. Applicants note that the Examiner, or any other member of the public, may readily obtain the English text of WO 01/02359 (and thus PCT/JP00/04298). **Enclosed herewith** is an English version of WO 01/02359 (published as EP1193255), which was obtained from the EPO’s patent database through esp@cenet. In view of this English version of PCT/JP00/04298 and the relative dates, Applicants submit that Luzzio et al should not be available as a reference under 35 U.S.C. 102 and, therefore, this ground of rejection should be withdrawn. If, however, the Examiner deems this submission insufficient, Applicants will file a certified English translation of PCT/JP00/04298 upon notification of the same.

Applicants request acknowledgement that this ground of rejection has been withdrawn.

The rejection of Claims 1, 2, and 18-20 under 35 U.S.C. §102(b) over Arcamone et al is obviated by amendment.

Applicants note that this ground of rejection is based on the Examiner’s interpretation that the compound having CAS RN# 150691-34-2 reads on the claimed compounds. Applicants note that R<sup>1</sup> disclosed in Arcamone et al only relates to a cycloalkyl

corresponding to cyclopropyl. As such, Applicants have amended Claim 1 to specify that when the cycloalkyl group is a cyclopropyl group it has a substituent(s). Applicants note that this limitation corresponds to original Claim 3, which the Examiner has indicated as being allowable over the disclosure of Arcamone et al. Moreover, this amendment removes the alleged area of overlap between Arcamone et al and the presently claimed invention.

The standard for determining anticipation requires that the reference “must teach every element of the claim” (MPEP §2131). Accordingly, for the reasons set forth above, Arcamone et al fails to meet this standard.

Therefore, Applicants request withdrawal of this ground of rejection.

The rejection of Claims 1-20 under 35 U.S.C. §112, second paragraph, is obviated by appropriate amendment.

Applicants wish to thank Examiner Patel for the helpful suggestions to address this ground of rejection.

Withdrawal of this ground of rejection is requested.

Finally, the Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1-20 (in part), drawn to compounds, composition, and a method of use for Formula (I), wherein R<sup>1</sup> is a cycloalkyl/cycloalkenyl; A is a pyridine; B is an aromatic ring and

Group II: Claims 1-20 (in part), drawn to compounds, not included in Group I, i.e. A is a pyrimidine, a pyrazine, etc.

In addition, for the elected group, the Examiner has requested an Election of Species.

Applicant affirms the election of Group I, with traverse. Applicants also affirm the election, with traverse, of the compound of Example 43 (page 81) as the single disclosed species. Claims 1, 4-9, and 12-20 read on the elected species.

Applicants note that the Examiner has not met the burden necessary to demonstrate the propriety of the Restriction Requirement. MPEP §803 states: "Examiners must provide reasons and/or example to support conclusions..." In the present case, the Examiner merely states his conclusions, but has not provided any reasons to support his conclusion. All the Examiner has stated is that the compounds of Groups I-II are drawn to structurally diverse compounds and cites a few pieces of art. Applicants submit that this statement is insufficient to meet the requisite burden to support restriction.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has failed to show that a burden would exist in searching all the claims of the present application.

MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions.

Applicants submit that a search and examination of all the claims would not constitute a series burden upon the Examiner.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples

to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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